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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,668	02/13/2002	Alan E. Shluzas	A31-6014	2672

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EXAMINER

RAMANA, ANURADHA

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,668

Applicant(s)

SHLUZAS, ALAN E.

Examiner

Anu Ramana

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-29 and 31-47 is/are rejected.
- 7) ☒ Claim(s) 6 and 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on February 13, 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 41-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 41, it is unclear what structure is being referred to by the phrase "said member including means for applyingto each other." It appears that the member by itself performs the stated function.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7-12 and 14-29 and 31-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Farris et al. (US 6,485,491).

Farris et al. disclose an apparatus 20 including: a housing 22d; a longitudinal member 36 received in a first opening of housing 22d; a washer or spacer 26d with received in a first opening of housing 22d; a fastener 24 engageable with a bone portion to connect member 36 to the bone portion wherein fastener 24 has a first part spherical surface engageable with housing 22d and a second part spherical surface engageable with spacer 26d; a snap-ring or "compressible member" or "spring member" 28 that applies a force and has a gap; and a clamping mechanism or set screw 30 that clamps longitudinal member 36 in housing 22d (Figures 1, 17 and 53, col. 5, lines 9-15, col. 6, lines 4-39 and lines 54-67, col. 7, lines 1-31 and col. 11, lines 6-44).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Farris et al. in view of Jepson et al. (US 5,135,489).

Although Farris et al. do not disclose slots on spacer 26d, it is the Examiner's position that providing axial slots on the outer surface of a body to enhance gripping of a body by a tool or hand are well known as evidenced by Jepson et al. (US 5,135,489) (see Figure 48 and col. 18, lines 46-49).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided slots on the outer surface of spacer 26d of Farris et al. to enhance gripping of the spacer since it was known in the art to provide slots on the outer surface of a body to enhance gripping of a body. It is noted that the phrase "that receive a tool for inserting said spacer into said housing" is deemed to be a functional recitation and has thus not been given any patentable weight.

Response to Arguments

Applicant's arguments submitted under "REMARKS" in the response submitted on March 17, 2004 have been fully considered but are not persuasive with respect to claims 1-5, 7-12 and 14-17. Applicant's arguments are persuasive with respect to claim 6.

Applicant's arguments that Farris et al. do not describe or suggest a member applying a force to prevent relative movement between a fastener and a housing when the longitudinal member is disengaged from the spacer and the spacer engages the fastener are not persuasive. It is the Examiner's position that in the device of Farris et al., whether longitudinal member 36 is

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disengaged from or engaged with spacer 26d has no effect on the position of fastener 24 with respect to housing 22d as long as fastener 24 is engaged with spacer 26d through snap-ring 28.

Further, regarding Applicant's arguments that snap ring 28' of Farris et al. does not apply a force, it is the Examiner's position that Farris et al. states that snap ring 28 is placed in the groove of housing 22 in a compressed condition (col. 5, lines 31-53 and col. 7, lines 12-31), thus the snap ring 28 applies a force due to its compressed state.

Applicant's arguments with respect to claims 2-5, 7-12 and 14-17 fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the prior art.

Regarding claim 13, in response to Applicant's argument that there is no suggestion to combine Farris et al. and Jepson et al., the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. In this case, Jepson et al. clearly shows axial slots on a body for enhancing gripping of the body by a tool or any other means. Thus a person of ordinary skill in the art at the time the invention was made would have been motivated to provide slots on the Farris et al. spacer 26d to enhance gripping of the spacer.

Allowable Subject Matter

Claims 6 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (703) 306-4035. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR *Anu Ramana*

June 3, 2004

Kevin Shaver
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